

**REMARKS**

Claims 7 and 10-25 are pending in the present Application. Claims 18-25 have been allowed. Claims 7 and 10-17 have been finally rejected.

Reconsideration and removal of the final rejection as to claims 7 and 10-17 is respectfully requested in view of the following remarks.

**Double Patenting Rejections**

**Rejection of claims 16 and 17 over claims 24-31 of U.S. Patent No. 6,039,569.**

Claims 16 and 17 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 24-31 of U.S. Patent No. 6,039,569.

Applicants hereby submit an executed Terminal Disclaimer with respect to U.S. Patent No. 6,039,569 in compliance with 37 CFR 1.321(c) to overcome the rejection. In response to the PTO's comments, it is noted that an attorney of record has signed the attached Terminal Disclaimer.

No new fee has been submitted, as it is believed that the requisite fee of \$55.00 has previously been paid. However, deposit account authorization to charge any such fees has been given in the event that the required statutory disclaimer fee has not been paid.

Entry of the Terminal Disclaimer and removal of the rejection with respect to U.S. Patent No. 6,039,569 is respectfully requested.

**Rejection of claims 7 and 10-15 over claims 1-14 and 24-25 of U.S. Patent No. 6,186,790 in view of U.S. Patent No. 6,039,569.**

Claims 7 and 10-15 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 and 24-25 of U.S. Patent No. 6,186,790 in view of U.S. Patent No. 6,039,569.

Applicants hereby submit a second executed Terminal Disclaimer. This second Terminal Disclaimer relates to U.S. Patent No. 6,186,790 and is in compliance with 37 CFR 1.321(c) and

has been signed by an attorney of record.

No new fee has been submitted, as it is believed that the requisite fee of \$55.00 has previously been paid. However, deposit account authorization to charge any such fees has been given in the event that the required statutory disclaimer fee has not been paid.

Entry of this second Terminal Disclaimer is respectfully requested. Removal of the rejection as to claims 7 and 10-15 over claims 1-14 and 24-25 of U.S. Patent No. 6,186,790 in view of U.S. Patent No. 6,039,569 is respectfully requested.

Rejection of claims 7 and 10-15 and 17 over claims 1-5 of U.S. Patent No. 6,200,136.

Claims 7-15 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-5 of U.S. Patent No. 6,200,136.

Applicants must respectfully disagree with the basis of rejection. Per MPEP 804, an "...analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 19 U.S.P.Q.2d 1289 (Fed. Cir. 1991).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

The disclosures of claims 1-5 of the '136 patent fail to meet the standard for a prima facie case of obviousness. In particular, the '136 patent fails to disclose all of the claim limitations and/or to provide a suggestion or motivation to modify the reference so as to obtain the claimed invention.

For example, the '136 patent is silent with respect to Applicants' requirement that the fibers in the structural component be greater than 10 mm, while the fibers in the pontic have a

maximum length of no greater than  $\frac{1}{4}$  inch.

All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Even if the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the *desirability* of such a modification. *In re Laskowski*, 10 U.S.P.Q.2d 1397, 1398 (Fed Cir. 1989).

In this case, there is simply no suggestion or motivation in any of claims 1-5 of the '136 patent to do what Applicants have done in the invention of independent claim 7. Accordingly, it is respectfully submitted that claims 1-5 of the '136 patent fail to provide an adequate basis for an obviousness-type double patent rejection with respect to independent claim 7.

Reconsideration and removal of the rejection as to independent claim 7 and dependent claims 10-15 is respectfully requested.

Conclusion

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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